



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH NORTH CAROLINA 27627

COPY MAILED

MAY 12 2004

In re Application of
French et al.
Application No. 09/497,822
Filed: February 3, 2000
Attorney Docket No. 5470-130DIV

: **OFFICE OF PETITIONS**
:
: **DECISION ON PETITION**
:
:

This is in response to the communication filed October 14, 2003, entitled "Submission of Decision on the Renewed Petition under 37 CFR 1.137(a)", which is being treated as a petition under 37 CFR 1.183 for waiver of 37 CFR 1.137(d).

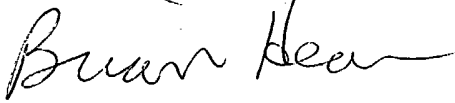
The petition is granted.

Applicants note that a favorable decision mailed June 24, 1997, on the petition filed under 37 CFR 1.137(a) in parent application No. 07/182,646 required *inter alia*, that a copy of the decision and the terminal disclaimer filed with the petition be filed in any continuing application, and further, that, applicants request that the terminal disclaimer be recorded against the continuing application. While applicants have compliantly filed herein a copy of the decision and the terminal disclaimer in this continuing application, applicants assert that, in light of the rules promulgated subsequent to the decision, it is no longer required or necessary that the terminal disclaimer be recorded against this application.

The rule change effective December 1, 1997, nevertheless required in 37 CFR 1.137(c) (now (d)) that "[t]he terminal disclaimer must also apply to any patent granted on any continuing application entitled under 35 U.S.C. 120 to the benefit of the filing date of the application for which revival is sought." As noted in MPEP 711.03(c)III(G), the terminal disclaimer would only be excused if the parent application had been revived strictly for continuity with this application; however as the parent application was revived in 1997 and this application was not filed until 2000, such is not the case. It follows that, as explained in MPEP 711.03(c)III(G), applicants are, in essence seeking relief by waiver of the rules of the necessity of recording the terminal disclaimer against this application. It is noted that the instant application claims § 120 benefit of the parent application which was filed April 15, 1988, and further, some 74 months of term were disclaimed in the parent case. Thus, the longest term the instant application can enjoy as a patent expires April 15, 2008; if the same 74 months were also disclaimed herein no term would be available to any forthcoming patent. It is agreed that justice would be served by waiver of the requirement that the terminal disclaimer be recorded against the instant continuing application. Since the disclaimed period of 74 months will not be accepted herein, then petitioners have disclaimed the period that would extend beyond 20 years from April 18, 1988, the earliest date claimed under 35 U.S.C. §§ 120, 121, or 365(c). See MPEP 711.03(c)III(G).

The \$130 petition fee has been charged

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

A handwritten signature in cursive script, reading "Brian Hearn". The signature is written in black ink and is positioned above the printed name and title.

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy